

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 5-29, 31-33, and 35-39 are pending in this application. Claims 1, 29, and 36-38 are amended by the present amendment. As amended Claims 1, 29, and 36-38 are supported by the original claims, no new matter is added.

Applicants gratefully acknowledge the indication that Claims 9-11, 14, 18-20, 25, 27, 28, 38, and 39 contain patentable subject matter.

In the outstanding Official Action, Claims 36-39 were rejected under 35 U.S.C. §112, second paragraph, Claims 36 and 37 were rejected under 35 U.S.C. §102(b) as anticipated by Dixon (U.S. Patent No. 5,544,431), Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over Allen (U.S. Patent No. 5,203,095) in view of Jacinto (U.S. Patent No. 4,592,153); Claims 5-7, 21, 22, and 26 were rejected under 35 U.S.C. §103(a) as unpatentable over Allen in view of Jacinto and further in view of Lombardino (U.S. Patent No. 6,751,891); Claims 8 and 12 were rejected under 35 U.S.C. §103(a) as unpatentable over Allen in view of Jacinto and Lombardino and further in view of Preman et al. (U.S. Patent No. 5,224,280, hereinafter “Preman”); Claims 13, 29, 31-33, and 35 were rejected under 35 U.S.C. §103(a) as unpatentable over Allen in view of Jacinto, Lombardino, and Preman and further in view of Dixon; Claims 15 and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over Allen in view of Jacinto and Preman; Claim 17 was rejected under 35 U.S.C. §103(a) as unpatentable over Allen in view of Jacinto and Preman and further in view of Dixon; Claims 23 and 24 were rejected under 35 U.S.C. §103(a) as unpatentable over Allen in view of Jacinto and Lombardino further in view of Preman.

With regard to the rejection of Claims 36-39 under 35 U.S.C. §112, second paragraph, Claims 36-38 are amended to replace certain instances of “cushioning arrangement” with

“cushioning element.” Accordingly, Claims 36-39 are believed to be in compliance with all requirements under 35 U.S.C. §112, second paragraph.

Amended Claim 1 recites in part, “a space *that can be seen and touched from an exterior of said shoe* is provided between adjacent ones of said first plurality of cushioning elements.”

The outstanding Office Action conceded that Allen does not teach such a space and cited the area occupied by soft resilient material 37 of Jacinto as “a space.”<sup>1</sup> However, this “space” cannot be seen or touched from an exterior of said shoe, as the heel construction of Jacinto is “completely enclosed.”<sup>2</sup> Thus, it is respectfully submitted that neither Allen nor Jacinto teaches or suggests “a space” as defined in amended Claim 1. Consequently, Claim 1 (and Claims 5-20 dependent therefrom) is patentable over Allen in view of Jacinto.

With regard to the rejection of Claims 5-7 as unpatentable over Allen in view of Jacinto and further in view of Lombardino, it is noted that Claims 5-7 are dependent from Claim 1, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Lombardino does not cure any of the above-noted deficiencies of Allen and Jacinto. Accordingly, it is respectfully submitted that Claims 5-7 are patentable over Allen in view of Jacinto and further in view of Lombardino.

With regard to the rejection of Claims 8 and 12 as unpatentable over Allen in view of Jacinto and Lombardino and further in view of Preman, it is noted that Claims 8 and 12 are dependent from Claim 1, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Preman does not cure any of the above-noted deficiencies of Allen, Jacinto, and Lombardino. Accordingly, it is respectfully submitted that Claims 8 and 12 are patentable over Allen in view of Jacinto and Lombardino and further in view of Preman.

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<sup>1</sup>See outstanding Office Action at page 4, lines 5-11.

<sup>2</sup>See Jacinto, column 5, lines 53-60.

With regard to the rejection of Claim 13 as unpatentable over Allen in view of Jacinto, Lombardino, and Preman and further in view of Dixon, it is noted that Claim 13 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Dixon does not cure any of the above-noted deficiencies of Allen, Jacinto, Lombardino, and Preman. Accordingly, it is respectfully submitted that Claim 13 is patentable over Allen in view of Jacinto, Lombardino, and Preman and further in view of Dixon.

With regard to the rejection of Claims 15 and 16 as unpatentable over Allen in view of Jacinto and further in view of Preman, it is noted that Claims 15 and 16 are dependent from Claim 1, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Preman does not cure any of the above-noted deficiencies of Allen and Jacinto. Accordingly, it is respectfully submitted that Claims 15 and 16 are patentable over Allen in view of Jacinto and further in view of Preman.

With regard to the rejection of Claim 17 as unpatentable over Allen in view of Jacinto and Preman and further in view of Dixon, it is noted that Claim 17 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Dixon does not cure any of the above-noted deficiencies of Allen, Jacinto, and Preman. Accordingly, it is respectfully submitted that Claim 17 is patentable over Allen in view of Jacinto and Preman and further in view of Dixon.

With respect to the rejection of Claim 21 as unpatentable over Allen in view of in view of Jacinto and further in view of Lombardino, that rejection is also respectfully traversed.

Claim 21 recites in part, “a second cushioning assembly disposed adjacent to said first cushioning assembly on a lateral side of said first cushioning assembly.”

In contrast, Figure 6 of Lombardino, cited in the outstanding Office Action as describing first through fifth cushioning assemblies,<sup>3</sup> illustrates a shoe with springs 50 *offset* from each other, rather than adjacent on a lateral side of each other. In fact, the outstanding Office Action concedes that the springs 50 are “staggered” from each other. Thus, as Lombardino does not describe any springs that are adjacent on a lateral side of any other spring, Lombardino does not teach or suggest “a second cushioning assembly” as recited in Claim 21. Further, it is respectfully submitted that neither Allen nor Jacinto teach or suggest this feature either. Accordingly, Claim 21 (and Claims 22-28 dependent therefrom) are believed to be patentable over Allen in view of Jacinto and further in view of Lombardino.

With regard to the rejection of Claims 23 and 24 as unpatentable over Allen in view of Jacinto and Lombardino and further in view of Preman, it is noted that Claims 23 and 24 are dependent from Claim 21, and thus are believed to be patentable for at least the reasons discussed above with respect to Claim 21. Further, it is respectfully submitted that Preman does not cure any of the above-noted deficiencies of Allen, Jacinto, and Lombardino. Accordingly, it is respectfully submitted that Claims 23 and 24 are patentable over Allen in view of Jacinto and Lombardino and further in view of Preman.

With respect to the rejection of Claim 29 as unpatentable over Allen in view of Jacinto, Lombardino, and Preman and further in view of Dixon, that rejection is also respectfully traversed.

Amended Claim 29 recites “a space *that can be seen and touched from an exterior of said shoe* is provided between adjacent ones of said plurality of cushioning elements.”

The outstanding Office Action cited the Dixon as describing that “a space is provided between adjacent ones of said plurality of cushioning elements.” However, springs 28, 30, 32, and 34 of Dixon are located in a hollow in the inner portion 18 of the heel of Dixon.

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<sup>3</sup>See outstanding Office Action at page 3, lines 21-23.

Thus, any spaces between springs 28, 30, 32, and 34 of Dixon *cannot be seen and touched from an exterior of the shoe*. Accordingly, Dixon does not teach or suggest “a space” as defined in amended Claim 29. Further, it is respectfully submitted that none of Allen, Jacinto, Lombardino, and Preman teach or suggest such a space either. Thus, Claim 29 (and Claims 31-33 and 35 dependent therefrom) is believed to be patentable over Allen in view of Jacinto, Lombardino, and Preman and further in view of Dixon.

With respect to the rejection of Claim 36 as anticipated by Dixon, that rejection is also respectfully traversed.

Amended Claim 36 recites in part “said central cushioning arrangement including a plurality of cushioning ribs *spaced apart from each other in a lengthwise direction of said shoe* and extending in a widthwise direction of said shoe.”

The outstanding Office Action cited insert 50 of Dixon as “a central cushioning arrangement” and tabs 52 as “a plurality of cushioning ribs.” However, insert 50 of Dixon includes at most two tabs that extend in a widthwise direction, and these tabs are not *spaced apart from each other in a lengthwise direction of the shoe*.<sup>4</sup> Accordingly, Dixon does not teach “a central cushioning arrangement” as defined in amended Claim 36. Accordingly, Claim 36 (and Claims 37-39 dependent therefrom) is not anticipated by Dixon and is patentable thereover.

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<sup>4</sup>See Dixon, Figure 2.

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Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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